UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,797	12/03/2001	Jeffrey Scott Weaver	10010092-1	7072

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER
LAM, ANDREW H

ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)
Office Action Summary		09/998,797	WEAVER, JEFFREY SCOTT
		Examiner	Art Unit
		Andrew H. Lam	2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
    closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-21* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____ .
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
          application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date *12/13/01*.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: on

page 10 of the specification lines 14-15, states "Upon actuating the "okay"

actuator 1050", the fig. 10 does not have a reference number for the "okay"

actuator.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section

122(b), by another filed in the United States before the invention by the applicant for patent or (2) a

patent granted on an application for patent by another filed in the United States before the invention by

the applicant for patent, except that an international application filed under the treaty defined in section

351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2)

of such treaty in the English language.

Claims 1, 2, 3, 6, 7, 8, 17, 18, 20 and 21 are rejected under 35 U.S.C.

102(e) as being anticipated by Mazzagatte et al (U.S. 6862583).

Regarding claim 1, Mazzagatte discloses a method for providing

documents to an authorized user, said method comprising: receiving, via a

computer network (fig. 1, network 100 connected to clients 10 and 20 with

printers 30 and 57), information to be printed and first information corresponding

to a user (col. 8, lines 19, sender submits print job with unique identification

information); receiving second information corresponding to a user (col. 9, lines

32-34, the intended recipient then arrived at the printer and present the proper

authentication information in order to process the print job); comparing the first

information to the second information (col. 9, lines 56-61, the intended recipient

is "challenge/response" to verify the integrity of the unique identification

information) ; and enabling printing of the information to be printed if the second

information corresponds to the first information (col. 9, lines 61-62, once the

recipient is authenticated, the printer then proceeds with the printout process).

Regarding claim 2, Mazzagatte discloses the method of claim 1, further

comprising: providing a printing device (fig. 1, image forming device 50); and

wherein receiving second information corresponding to a user comprises:

receiving the second information from the user at the printing device (col. 9, lines

42-44, the intended recipient presents authentication information to the printer).

Regarding claim 3, Mazzagatte discloses the method of claim 2, further

comprising: providing an identification device configured to transmit the second

information (col. 9, lines 50-51, the user transmit the unique identification

information in digital form to the printer, i.e. smart-card); and wherein receiving

the second information is enabled when the identification device is in a proximity

of the printing device (col. 9, lines 50-55, the intended recipient insert the smart-

card containing unique identification information into the smart-card reader).

Regarding claim 6, Mazzagatte the method of claim 1, further comprising:

determining whether the second information is being received; and discontinuing printing of the information to be printed if the second information is not being received (col. 9, lines 32-35, the print job is held in the print queue and can not be process further until the recipient present the proper authentication information in order to retrieve the print job and have it printed).

Regarding claim 7, Mazzagatte discloses the method of claim 1, further comprising: preventing the information to be printed from being printed if the second information does not correspond to the first information (col. 9, lines 62-65, if the authentication failed then the printer does not process the print job).

Regarding claim 8, Mazzagatte discloses the method of claim 1, further comprising: storing the information to be printed and the first information at a time after receipt (col. 9, lines 8-10, once the printer receive the print data and the digital certificate the information is stored, i.e. is stored in print queue); and erasing the information to be printed at a time after printing (col. 10, lines 15-20, the intended recipient uses the smart-card to authenticate himself, once authenticated the job is printed from the print queue--it is known in the art that a print queue is a lineup of items waiting to be printed and that the job will be removed from the queue once it is processed).

Regarding claim 17, Mazzagatte discloses a print system (fig. 1, printing system) comprising: a print authorization system (fig. 1, smart card reader 35) configured to: receive, via a computer network (fig. 1, network 100), information to be printed and first information corresponding to a user (col. 8, lines 19, sender submits print job with unique identification information); receive second

information corresponding to a user (col. 9, lines 32-34, the intended recipient

then arrived at the printer and present the proper authentication information in

order to process the print job); compare the first information to the second

information (col. 9, lines 56-61, the intended recipient is "challenge/response" to

verify the integrity of the unique identification information); and enable printing of

the information to be printed if the second information corresponds to the first

information (col. 9, lines 61-62, once the recipient is authenticated, the printer

then proceeds with the printout process).

Regarding claim 18, Mazzagatte discloses the print system of claim 17,

wherein the print authorization system is further configured to determine whether

the second information is being received and discontinue printing of the

information to be printed if the second information is not being received (col. 9,

lines 32-35, the print job is held in the print queue and can not be process further

until the recipient present the proper authentication information in order to

retrieve the print job and have it printed).

Regarding claim 20, Mazzagatte discloses a computer readable medium

(col. 5, lines 11-13, fixed disk 280 is an example of a computer readable medium

that stores program instruction sequences executeable by a CPU, see fig. 2)

comprising: logic configured (fig. 3, control logic 320) to receive information to be

printed and first information corresponding to a user (col. 8, lines 19, sender

submits print job with unique identification information); logic configured (fig. 3,

smartcard interface 365) to receive second information corresponding to a user

(col. 9, lines 32-34, the intended recipient then arrived at the printer and present

the proper authentication information in order to process the print job); logic

configured (fig. 3, printer memory 51) to compare the first information to the

second information(col. 9, lines 56-61, the intended recipient is

"challenge/response" to verify the integrity of the unique identification

information); and logic configured (fig. 3, printer memory 51) to enable printing of

the information to be printed if the second information corresponds to the first

information (col. 9, lines 61-62, once the recipient is authenticated, the printer

then proceeds with the printout process).

Regarding claim 21, Mazzagatte discloses the computer readable medium

of claim 20, further comprising: logic configured to determine whether the second

information is being received; and logic configured (fig. 3, printer memory 51) to

discontinue printing of the information to be printed if the second information is

not being received (col. 9, lines 32-35, the print job is held in the print queue and

can not be process further until the recipient present the proper authentication

information in order to retrieve the print job and have it printed).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described
> as set forth in section 102 of this title, if the differences between the subject matter sought
> to be patented and the prior art are such that the subject matter as a whole would have been
> obvious at the time the invention was made to a person having ordinary skill in the art to which
> said subject matter pertains. Patentability shall not be negatived by the manner in which the
> invention was made.

Claims 4,5, 9-16, and 19, rejected under 35 U.S.C. 103(a) as being

unpatentable over Mazzagatte in view of Herbert (U.S. 6212505).

Regarding claim 4 which depends on claim 2, Mazzagatte discloses a

method for providing documents to an authorized user, said method comprising:

receiving, via a computer network (fig. 1, network 100 connected to clients 10

and 20 with printers 30 and 57), information to be printed and first information

corresponding to a user (col. 8, lines 19, sender submits print job with unique

identification information); receiving second information corresponding to a user

(col. 9, lines 32-34, the intended recipient then arrived at the printer and present

the proper authentication information in order to process the print job); comparing

the first information to the second information (col. 9, lines 56-61, the intended

recipient is "challenge/response" to verify the integrity of the unique identification

information) ; and enabling printing of the information to be printed if the second

information corresponds to the first information (col. 9, lines 61-62, once the

recipient is authenticated, the printer then proceeds with the printout process).

Mazzagatte does not disclose expressly a method for storing third

information; providing a print cartridge configured to transmit fourth information,

said print cartridge being installed in the printing device and containing ink for

printing; comparing the third information to the fourth information; and enabling

printing of the information to be printed if the fourth information corresponds to

the third information.

Herbert discloses a method for using a smart device on the cartridge to

communicate with a sensor port connected to the microprocessor. The

microprocessor reads data recorded in the smart device and if the unique identity

of the print head module read from the smart device is recognized by the

microprocessor of the postage meter, the microprocessor continues with the

postage printing (col.4, lines 9-14).

It would have been obvious to one of ordinary skill in the art at the time of

the invention was made to modify Mazzagatte as per teaching of Herbert

because of the following reason: by using a smart device embedded on the ink

cartridge measures are taken to ensure that only authorized print cartridge are

used to connect to the printing device (col. 3, lines 62-67). Thus, achieving the

objective of Mazzagatte, which is to authenticate secure printing of document for

the intended recipient.

Regarding claim 5, which depends from claim 4, the combination further

teaches [in Herbert]: wherein storing the third information and comparing the third

information to the fourth information is performed at the printing device (the

microprocessor reads data recorded in the smart device and if the unique identity

of the print head module read from the smart device is recognized by the

microprocessor of the postage meter, the microprocessor continues with the

postage printing (col.4, lines 9-14).

Regarding claim 9, Mazzagatte discloses print system (fig. 1, printing

system) comprising: providing documents to an authorized user, said apparatus

comprising: receiving, via a computer network (fig. 1, network 100 connected to

clients 10 and 20 with printers 30 and 57), information to be printed and first

information corresponding to a user (col. 8, lines 19, sender submits print job with

unique identification information); receiving second information corresponding to

a user (col. 9, lines 32-34, the intended recipient then arrived at the printer and

present the proper authentication information in order to process the print job);

comparing the first information to the second information (col. 9, lines 56-61, the

intended recipient is "challenge/response" to verify the integrity of the unique

identification information) ; and enabling printing of the information to be printed if

the second information corresponds to the first information (col. 9, lines 61-62,

once the recipient is authenticated, the printer then proceeds with the printout

process).

Mazzagatte does not disclose expressly a printing device having a first

print cartridge and an identification reader, the first print cartridge containing a

print substance for printing on a print medium, the first cartridge having a

transmitter readable identification tag for providing first information, the

identification reader being configured to receive the first information from the

identification tag, such that, if the first information corresponds to the printing

device, the identification reader enables the printing device to print

Herbert discloses a printing device for using a smart device on the

cartridge to communicate with a sensor port connected to the microprocessor.

The microprocessor reads data recorded in the smart device and if the unique

identity of the print head module read from the smart device is recognized by the

microprocessor of the postage meter, the microprocessor continues with the

postage printing (col.4, lines 9-14).

It would have been obvious to one of ordinary skill in the art at the time of

the invention was made to modify Mazzagatte as per teaching of Herbert

because of the following reason: by using a smart device embedded on the ink

cartridge measures are taken to ensure that only authorized print cartridge are used to connect to the printing device (col. 3, lines 62-67). Thus, achieving the objective of Mazzagatte, which is to authenticate secure printing of document for the intended recipient.

Regarding claim 10, which depends from claim 9, the combination further teaches [in Mazzagatte] wherein the identification reader includes a receiver (col. 8, line 34, smart card reader 15, see fig. 1), the receiver being adapted to receive the first and third information via wireless communication (col. 9, line 52, insert smart card into smart card reader).

Regarding claim 11, which depends from claim 9, the combination further teaches [in Mazzagatte], wherein the identification reader includes means for receiving information via wireless communication (col. 9, line 52, insert smart card into smart card reader).

Regarding claim 12, which depends from claim 9, the combination further teaches [in Mazzagatte], further comprising: user identification tag adapted to communicate with the identification reader via wireless communication (col. 9, line 52, insert smart card into smart card reader), the identification tag including a memory (inherently smart card holds some sort of identification number therefore it has memory), the memory storing data corresponding to the third information (col 8, lines 35-37, the smart card contain the recipient's unique identification information in digital form), the user identification tag being adapted to provide the third information to the identification reader (col. 9, line 52, insert smart card into smart card reader).

Regarding claim 13, which depends from claim 9, the combination further teaches [in Herbert], further comprising: a second print cartridge having an identification reader, the second print cartridge containing a print substance for printing on a print medium and a readable identification tag for providing the first information, the second print cartridge being adapted to be installed in the printing device after the first print cartridge is removed from the printing device (col. 3, lines 62-67, the first cartridge is removed and a new print cartridge (second print cartridge) is installed, col. 4, lines 9-14 the microprocessor reads data recorded in the smart device and if the unique identity of the print head module read from the smart device is recognized by the microprocessor of the postage meter, the microprocessor continues with the postage printing).

Regarding claim 14, which depends from claim 9, the combination further teaches [in Mazzagatte], wherein the print authorization system is a print-end print authorization system implemented by the printing device (fig. 1, smart card read 15 is attached to pc 15); and further comprising: a user-end print authorization system adapted to communicate with the printing device (col. 4, lines 23-25, smart card reader 35 is interface with copier 30, see fig 1), the user-end print authorization system being configured to enable a user to provide the second information to the print-end print authorization system via a communication network (fig. 1, network 100, interface communication between the user pc 10 and the printer 30).

Regarding claim 15, which depends from claim 9, the combination further teaches [in Mazzagatte], wherein the user-end print authorization system is

adapted to provide a user interface (fig. 2, display interface 250), the user
interface enabling a user to designate information to be printed and select a
secure-enable mode (col. 7, line 57-58, one can select secure or non-secure
transmission mode) such that, when the user selects the secure-enable mode,
the information to be printed can only be printed by the printing device while the
identification reader receives the third information (col. 9, lines 32-35, the print
job is held in the print queue and can not be process further until the recipient
present the proper authentication information in order to retrieve the print job and
have it printed).

Regarding claim 16, which depends from claim 9, the combination further
teaches [in Mazzagatte], wherein the printing device includes memory (fig. 3,
printer memory 51), the printing device being configured to store the information
to be printed (fig. 3, queue 356 to store print job) and the first information in the
memory at a time after receipt (col. 8, lines 19, sender submits print job with
unique identification information), the printing device being further configured to
render the information to be printed inaccessible from the memory at a time after
printing (col. 10, lines 15-20, the intended recipient uses the smart-card to
authenticate himself, once authenticated the job is printed from the print queue--it
is known in the art that a print queue is a lineup of items waiting to be printed and
that the job will be removed from the queue once it is processed).

Regarding claim 19, which depends from claim 17, the combination further
teaches [in Herbert], further comprising: a printing device communicating with the
print authorization system, the printing device having a first print cartridge and an

identification reader, the first print cartridge containing a print substance for

printing on a print medium, the first cartridge having a readable identification tag

for providing first information, the identification reader being configured to receive

the first information from the identification tag, such that, if the first information

corresponds to the printing device, the identification reader enables the printing

device to print; and wherein the print authorization system is implemented in

logic associated with the printing device(col. 3, lines 62-67, the first cartridge is

removed and a new print cartridge (second print cartridge) is installed, col. 4,

lines 9-14 the microprocessor reads data recorded in the smart device and if the

unique identity of the print head module read from the smart device is recognized

by the microprocessor of the postage meter, the microprocessor continues with

the postage printing).

Contact Information

Any inquiry concerning this communication or earlier communications from

the examiner should be directed to Andrew H. Lam whose telephone number is

(571) 272-8569. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The

fax phone number for the organization where this application or proceeding is

assigned is 703-872-9306.

Information regarding the status of an application may be obtained from

the Patent Application Information Retrieval (PAIR) system. Status information

for published applications may be obtained from either Private PAIR or Public

PAIR. Status information for unpublished applications is available through

Private PAIR only. For more information about the PAIR system, see http://pair-

direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).

DAVID MOORE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600